

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: ) Examiner: Rachel L. Porter  
EDWARD J. PETRUS )  
Serial No. 09/444,660 ) Group Art Unit: 2166  
Filed: November 22, 1999 )  
For: DIETARY SUPPLEMENT SELECTOR AND METHOD

Assistant Commissioner for Patents  
Washington, DC 20231

RESPONSE TO OFFICE ACTION

In response to the Office Action mailed September 11, 2002, please make note of the following:

**1. The Office Action is not Final:**

The Final Action issued by the Examiner on September 11, 2002, is not final. The Applicant filed amendments on June 11, 2002, to the Examiner's March 20, 2002, office action. On June 13, 2002, a request was made to place the 6/11/02 changes in a clean and marked up version. No new amendments were filed on June 24, 2002, as claimed by the Examiner (Pgs. 2-4).

According to MPEP § 706.07(a), the Examiner can make the second or any subsequent actions on the merits final, "except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement." In the first office action dated March 20, 2002, the Examiner rejected all claims under § 102 as being anticipated by Summerell. In the office action dated September 11, 2002, the Examiner rejected the remaining claims 1-5 under § 103 as being unpatentable over Summerell and in view of Riley. If, as the examiner claims, the "[a]pplicant's

arguments filed 6/24/02 have been fully considered but they are not persuasive" (Pg. 9, lines 14-15) then there is no basis for the examiner introducing a new ground of rejection, and the second office action filed 9/11/02 can not be final. Furthermore, by introducing Riley as newly cited art, MPEP § 706.07(a) also holds that "the examiner may NOT make the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment." Since the examiner was not persuaded by the applicant's amended claims and remarks - there was no necessity to introduce a new ground of rejection and newly cited art.

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MPEP § 706.07 states that "[b]efore final rejection is in order a clear issue should be developed between the examiner and applicant." That has not happened in this case. No clear issue has been communicated to the applicant from the examiner. This case was filed 11/22/99 and the first office action was 3/22/02, twenty-eight (28) months later. Why the rush to close this case?

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Also § 706.07 states that going "from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter , will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection." The Examiner admits that "new ground(s) of rejection presented in this Office action." (Pg. 11, lines 12-13). Applicant maintains that the subject matter is the same but the references and grounds for rejection introduced by the examiner are changing. Therefore the office action is not final, but only the second office action in a three (3) year period of time, and by regulation should be open to a reply.

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